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No. 93-1577

IN THE

Supreme Court of the United States

OCTOBER TERM, 1993

QUALITEX COMPANY,

Petitioner,

v.

JACOBSON PRODUCTS CO., INC.,

Respondent.

TO BE DETERMINED

On Petition for Writ of Certiorari
to the United States Court of Appeals
for the Ninth Circuit

MOTION OF INTERNATIONAL TRADEMARK ASSOCIATION FOR LEAVE TO FILE BRIEF AMICUS CURIAE IN SUPPORT OF PETITIONER AND BRIEF AMICUS CURIAE OF INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF PETITIONER

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COMES NOW, THE INTERNATIONAL TRADEMARK ASSOCIATION ("INTA"), and pursuant to Supreme Court Rule 37.4, moves this Court for leave to file a brief amicus curiae in support of Petitioner in the above-captioned cause. This Motion is required because Respondent, through its counsel in the above-captioned cause, has

refused to grant its consent. Petitioner's letter of consent is filed herewith.

Movant INTA, founded in 1878 as the United States Trademark Association ("USTA"), is a not-for-profit corporation with over 2,700 members having a special interest in trademarks. INTA's members include trademark owners, advertising agencies, and law firms from the United States and foreign countries, including some of the world's foremost corporations. These members form an important segment of the United States business community and they and their counsel have substantial expertise in trademark law.

INTA members and other trademark owners presently face uncertainty in the interpretation and application of the United States Trademark Act (the "Lanham Act") with respect to marks consisting of color *per se*, because there exists a split in the courts of appeals on whether color *per se* is protectable and registrable under the Lanham Act.

On the authority of a decision of the Court of Appeals for the Federal Circuit, the United States Patent and Trademark Office ("PTO"), the administrative agency charged with responsibility for the implementation of the Lanham Act, has taken the position that the Lanham Act permits the registration of color *per se* if the statutory

requirements for registrability of a trademark are satisfied and has issued registrations of color marks, including the Petitioner's registration that was cancelled by the Ninth Circuit. The Eighth Circuit has held likewise that color *per se* is protectable and registrable, and would accord Principal Register registrations of color marks such as Petitioner's the full evidentiary status to which they are entitled in litigation under the Lanham Act.

The Seventh and Ninth Circuits, however, have reached an opposite conclusion and, as in the instant case, would hold PTO registrations of color marks invalid as a matter of law, and automatically cancelable. This disparate treatment of federal statutory rights will almost certainly result in forum shopping in cases involving color marks, a result inconsistent with the Lanham Act's purpose of nationalizing and harmonizing the protection of registered trademarks throughout the United States. INTA's members have a strong interest in a consistent, uniform interpretation of the Lanham Act in all jurisdictions in which federal registrations of marks may be asserted in litigation.

INTA takes no position on the issue of whether Petitioner's color mark was entitled to registration under the Lanham Act and was properly registered. INTA believes, however, that the language of the Lanham Act clearly provides that color marks may be registered when the

statutory requirements for registration are satisfied, and that the Ninth Circuit's decision to the contrary was incorrect as a matter of statutory law. INTA urges the Court in the brief amicus submitted herein to reach and settle the issue and bring certainty with respect to the development and enforcement of these important federal rights.

For all of the foregoing reasons, Movant respectfully requests leave to file the brief amicus curiae submitted herein.

Respectfully submitted,

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Upon motion for leave submitted herewith pursuant to Rule 37.4 of the Rules of the Court, amicus curiae International Trademark Association ("INTA") respectfully submits this Brief Amicus Curiae in

support of Petitioner Qualitex Company ("Petitioner"). INTA urges the Court to grant *certiorari* on Petitioner's Question 1 because it raises an important question of federal trademark law.

A significant split exists among the courts of appeals on the issue of whether color *per se*[1] is registrable as a trademark under the United States Trademark Act, 15 U.S.C. §§1051, *et seq.* (the "Lanham Act"). The courts of appeals that have considered the issue differ sharply on the validity and enforceability of federal registrations of color trademarks issued by the United States Patent and Trademark Office ("PTO"), the federal agency charged with the administration of the Lanham Act. The Court should grant *certiorari* to resolve this significant split in the circuits, to address the propriety of the PTO's practice of registering colors under the Lanham Act, and to foster the statutory goal of uniform protection of trademarks throughout the United States.

[1]As used in this brief, the term color *per se* refers to a single color or single shade of color, without any additional elements such as designs. *See NutraSweet Co. v. Stadt Co.*, 917 F.2d 1024, 1026 n.6 (CA7 1990).

INTEREST OF THE AMICUS CURIAE

INTA, founded in 1878 as the United States Trademark Association ("USTA"), is a not-for-profit corporation of more than 2,700 members having a special interest in trademarks. INTA's members include trademark owners, advertising agencies, and law firms from the United States and foreign countries, including some of the world's foremost corporations. These members form an important segment of the United States business community, and they and their counsel have substantial expertise in trademark law.

INTA's corporate members spend millions of dollars each year in the development, registration, and protection of their trademarks in the United States. All INTA members share an interest in protecting the integrity of the American trademark system through a coherent and consistent judicial treatment of federally-registered trademarks.

INTA has been instrumental in making recommendations and providing assistance to Congress in connection with the Lanham Act, most recently through the active participation of USTA's Trademark Review Commission in the development and enactment of the Trademark Law Revision Act of 1988 ("TLRA"), the most significant amendment of the Lanham Act since 1946. *See* 134 Congressional

Record (516974 daily ed. October 20, 1988). INTA has also participated in the past as an amicus curiae in trademark cases before this Court, *see, e.g., Two Pesos, Inc. v. Taco Cabana International, Inc.*, 120 L. Ed 615, 112 S Ct. 2753 (1992), and in many lower courts.

SUMMARY OF THE ARGUMENT

The split in the circuits on the issue of the protectability and registrability of color *per se* as a trademark jeopardizes the integrity of federal registrations of color marks and the uniform application of the Lanham Act's provisions regarding the evidentiary benefits accorded to the owner of a Principal Register registration. Unless the split is resolved, the statutory goal of nationwide protection of registered marks will be frustrated.

Color *per se* is subject matter that falls within the definition of "trademark" in §45 of the Lanham Act if it serves to identify and distinguish the source of a person's goods, and it has not been excluded in §2 of the Lanham Act from eligibility for registration. Accordingly, color *per se* is registrable if the statutory requirements for registration are satisfied, and any policy decision to change the current law must be left to Congress.

ARGUMENT

I.

There is a Conflict Among the Circuits on Whether Color Per Se is Registrable and Protectable Under the Lanham Act

A. The Conflict Among the Circuits Jeopardizes Registrations of Color Marks Issued Under Current PTO Practice

The courts of appeals have split sharply on whether color *per se* is protectable and registrable as a trademark under the Lanham Act. In the instant case, the Court of Appeals for the Ninth Circuit held that it was not and ordered the cancellation of Petitioner's United States Trademark Registration No. 1,633,711, issued on February 5, 1991 for the color green-gold for press pads and press pad covers, even though the Court simultaneously affirmed the entry of judgment on Petitioner's unfair competition claim on the basis of its trade dress, consisting largely of the green-gold color by itself. *Qualitex Co. v. Jacobson Products Co., Inc.*, 13 F.3d 1297 (CA9 1994).

The Ninth Circuit cited with approval the decision of the Seventh Circuit Court of Appeals in *Nutrasweet Co. v. Stadt Corp.*, 917 F.2d 1024 (CA7 1990), *cert. denied*, 499 U.S. 983 (1991), holding that the color blue was unprotectable as a matter of law under the Lanham Act as a trademark for a sugar substitute. The Ninth Circuit rejected the

views of the Eighth Circuit in *Master Distributors, Inc. v. Pako Corp.*, 986 F.2d 219 (CA8 1993), and the Federal Circuit in *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (CAFC 1985), two decisions that held that color *per se* is protectable and registrable under the Lanham Act if the applicable statutory requirements for trademark protection are otherwise satisfied.

On the authority of the Federal Circuit's decision in *Owens-Corning*, the PTO has instructed its trademark examining attorneys that under the Lanham Act "color can function as a trademark if it is used on goods in the manner of a trademark and if it is perceived by the public as identifying and distinguishing the goods on which it is used and indicating their source." *Trademark Manual of Examining Procedure*, §1202.04(e), at 1202-13 (2d Ed. 1993). The PTO will issue registrations of color trademarks, such as Petitioner's registration, if the PTO is satisfied that an applicant has shown that a color "has become distinctive of the applicant's goods in commerce." *Id.*

Before the PTO, "[t]he burden of proof in such a case is substantial," *id.*, in view of the Federal Circuit's admonition that "[b]y their very nature color marks carry a difficult burden in demonstrating

distinctiveness and trademark character." *Owens-Corning*, 774 F.2d at 1127. The conflict among the circuits forces a potential applicant for federal registration of a color mark to proceed at its peril because its efforts to obtain a registration by satisfying this substantial burden may be an exercise in futility if the holdings of the Seventh and Ninth Circuits, and not those of the Eighth and Federal Circuits, are adopted by other courts in future cases.

B. The Conflict Among the Circuits Jeopardizes the Uniform Application of the Lanham Act in Litigation

Whether a federal registration of a color mark will be accorded the evidentiary respect in litigation that the Lanham Act specifies, or will instead be cancelled automatically, is now uncertain. A Principal Register registration of a color mark is by statute "prima facie evidence of the validity of the registered mark and of the registration of the mark" and of "the registrant's exclusive right to use the registered mark in commerce," 15 U.S.C. §1057(b), but in reality the enforceability of such a registration depends upon the court in which the registration is asserted, or in which its owner becomes an involuntary litigant through the filing of a declaratory judgment suit.

A color mark registration that will give its owner substantial evidentiary benefits in litigation in the Eighth Circuit apparently will be invalidated as a matter of law in the Seventh and Ninth Circuits, and before any other courts that may choose to follow the latter two circuits in future cases, because those courts follow a "*per se* rule prohibiting the protection of color alone [that] would essentially render a valid color trademark registration ineffective and unenforceable." *Master Distributors*, 986 F.2d at 224. The inevitable result of this disparate treatment of federal statutory rights in different circuits will be forum shopping in suits involving color marks, a situation entirely inconsistent with the Lanham Act's "'sound public policy requir[ing] that trademarks should receive nationally the greatest protection that can be given them.'" *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193 (1985)(citation omitted).

The Court should grant *certiorari* to resolve the conflict among the circuits and to further the statutory goal of certainty and uniformity in the protection of federally-registered trademarks in the United States.

II.

The Lanham Act Does Not Exclude Color Per Se From the Marks That May Be Federally Registered and Any Decision to Do So is For Congress Alone to Make

A. The Statutory Definition of "Trademark" Does Not Exclude Color Per Se

The Lanham Act defines a "trademark" as "any word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish his or her goods, including a unique product, from those sold or manufactured by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. §1127. On its face, the statute's definition of "trademark" is sufficiently broad to include color *per se* provided that color is shown to identify and distinguish the user's goods.

In enacting the TLRA in 1988, three years after the Federal Circuit's decision in *Owens-Corning*, Congress broadened the Lanham Act's original definition of "trademark" "to reflect contemporary marketing practices and to make clear a trademark's function of distinguishing the goods of one person from those of another." S. Rep. No. 100-515, 100th Cong., 2d Sess. 44 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5607. In doing so, Congress chose--explicitly and unequivocally--not to disturb the PTO's practice of

registering color marks under *Owens-Corning* if the statutory conditions for registrability are satisfied; "[t]he revised definition intentionally retain[ed] . . . the words 'symbol or device' *so as not to preclude the registration of colors*, shapes, sounds or configurations where they function as trademarks." *Id.* (emphasis added).[2] Accordingly, there can be no doubt that a color which serves to identify and distinguish the source of a product falls within the statutory definition of a "trademark."

B. The Lanham Act Does Not Exclude Color Per Se From The Trademarks That Can Be Registered Under the Lanham Act and Color Per Se Thus Must Be Registrable

Because §2 of the Lanham Act provides that "[n]o trademark . . . shall be refused registration on the principal register on account of its nature unless" it falls within one of the categories of trademarks that are specifically excluded from registration,[3] 15 U.S.C. §1052, "a

[2]The quoted language in the Senate Report was taken almost verbatim from the Report and Recommendations of USTA's Trademark Review Commission Report, reported at 77 Trademark Reporter 375 (1987), in which the Commission "determined that the terms 'symbol, or device' should not be deleted or narrowed to preclude registration of such things as color, shape, smell, sound, or configuration which functions as a mark." 77 Trademark Reporter at 421.

[3] These categories prohibit, *inter alia*, the registration of a mark that "[c]onsists of or comprises immoral, deceptive, or scandalous matter," 15 U.S.C. §1052(a), a mark that "[c]onsists of or comprises

mark 'by which the goods of the applicant may be distinguished from the goods of others' . . . must be registered unless otherwise disqualified." *Two Pesos, Inc. v. Taco Cabana International, Inc.*, 120 L. Ed. 615, 626 (1992)(citation omitted).

The Ninth Circuit acknowledged in this case that "color is not listed as an exception" to registration under §2, and that "[r]egistration of mere color is not explicitly barred by the Lanham Act . . ." *Qualitex*, 13 F.3d at 1301. Nevertheless, the Court "conclude[d] that the better rule is that a trademark should not be registered for color alone," *Qualitex*, 13 F.3d at 1302, and cancelled Petitioner's registration.[4] The Court thus substituted its view of desirable federal trademark policy for that of Congress.

Congress has already decided the issue addressed by the Ninth Circuit and in the resulting language of the Lanham Act, Congress has expressed its intent that color *per se* should not automatically be precluded from registration. If the "better rule" is that color *per se*

the flag or coat or arms or other insignia of the United States," 15 U.S.C. §1052(b), and a mark that is confusingly similar to a previously-registered mark. 15 U.S.C. §1052(d).

[4]INTA takes no position on the factual issue of whether Petitioner's green-gold color satisfies the statutory requirements in §§2 and 45 of the Lanham Act for federal registration and was properly registered by the PTO.

should be unprotectable and unregistrable for any of the reasons identified by the Ninth Circuit or otherwise, it must be left to Congress to change the current law.

CONCLUSION

For all of the foregoing reasons, the Court should grant the Petition for a Writ of Certiorari on Question 1.

Respectfully submitted,

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